

REMARKS

Claims 1-20 are pending in the present application.

Claims 1-20 were rejected in the March 1, 2007 Office Action.

No claims have been allowed.

Claims 1, 8, 15, 19 and 20 are amended herein.

Claims 1-20 remain in the present application.

Reconsideration of the claims is respectfully requested.

I. CLAIM REJECTION UNDER 35 U.S.C. §112

Claims 19 and 20 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. This rejection is respectfully traversed.

There are two separate requirements under 35 U.S.C. §112, second paragraph. MPEP §2171, p. 2100-209 (8th ed., rev. 5, August 2006). The first is subjective and requires that the claims must set forth the subject matter that the *Applicants* regard as their invention. *Id.* The second is objective and requires that the claims must particularly point out and distinctively define the metes and bounds of the subject matter that will be protected by the patent grant (*i.e.*, whether the scope of the claim is clear to one of ordinary skill in the art). *Id.* at 2100-210. The Examiner should explain whether the rejection is based on indefiniteness or on the failure to claim what the Applicants regard as their invention. *Id.* (*citing Ex parte Ionescu*, 222 U.S.P.Q. 537, 539 (Bd. App. 1984)).

The Office suggests that Claims 19 and 20 are indefinite for a number of reasons. The Applicants have amended Claims 19 and 20 herein to overcome the §112 rejection. The amendments are fully supported by the originally filed Application and do not add new matter. The Applicants therefore respectfully request that the amendments to Claims 19 and 20 be entered.

Accordingly, the Applicants respectfully request the Office to withdraw the §112 rejection.

II. CLAIM REJECTION UNDER 35 U.S.C. §102

Claims 1-14 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,041,101 to *Lebre*, hereinafter “*Lebre*”. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-67 (8th ed., rev. 5, August 2006) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Claim 1 of the present application currently requires:

For use in a semiconductor process, a *tool for lifting a chemical mechanical polishing (CMP) pad*, the tool comprising:

a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the lower jaw portion having outer and inner surfaces, wherein the inner surface is substantially flat and not parallel to the outer surface, *the inner surface being operable to receive a portion of the CMP pad, wherein the CMP pad is used to polish a semiconductor wafer*;

a first member pivotally coupled to the non-pivoted jaw structure; and a second member pivotally coupled to the first member, the second member having a surface opposite to the inner surface of the lower jaw portion and operable for clamping the portion of

the CMP pad against the inner surface when the first member is pivoted upwards. (emphasis added).

Notably, Claim 1 requires *a non-pivoted jaw structure* having an upper jaw portion and a lower jaw portion, the lower jaw portion having outer and inner surfaces. The inner surface is substantially flat and not parallel to the outer surface, *the inner surface being operable to receive a portion of the CMP pad, wherein the CMP pad is used to polish a semiconductor wafer.* *Lebre* fails to teach each and every requirement of Claim 1 and its dependents.

Lebre fails to teach or disclose, for example, a “non-pivoted jaw structure” as required by Claim 1. In fact, *Lebre* teaches a clamping tong for plate-shaped loads having a two-tong jaw (i.e., jaw 1 and jaw 2) connected to each other by a *pivot pin*. (*Lebre*, column 1, lines 9-13; Figures 1 and 2). The jaw 1 forms one end of a double-armed lever 7. (*Id.* at column 1, line 45; Figures 1 and 2). On the lever end opposite to the jaw, another double armed lever 8 is *pivottally connected by a pivot pin* 9. (*Id.* at column 1, lines 46-47; Figures 1 and 2).

In addition, *Lebre* fails to teach or disclose, for example, a “non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the lower jaw portion having outer and inner surfaces, wherein the inner surface is substantially flat and no parallel to the outer surface, the inner surface being operable to receive a portion of the CMP pad, wherein the CMP pad is used to polish a semiconductor wafer,” as required by Claim 1. At most, *Lebre* teaches that *a roller 11 engages a control surface 12 is arranged to slant upward from the outer to the inner sides of the jaw 2.* (*Id.* at column 1, lines 53-56; Figures 1 and 2). When raising the carrying handle 10 in the direction of the

arrow P, the teeth 4, 5 and 6 grip on a corner of the load T that is to be lifted, the lever 8 moves toward a vertical position. (*Id.* at column 1, lines 57-60; Figures 1 and 2).

Lebre therefore fails to teach or disclose each and every element of Claim 1 and its dependents, Claims 2-7. Similar arguments hold true for Claim 8 and its dependents, Claims 9-14.

Accordingly, the Applicants respectfully request the Office to withdraw the §102 rejection.

III. CLAIM REJECTION UNDER 35 U.S.C. §103

Claims 5 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lebre*. This rejection is respectfully traversed. In addition, Claims 15-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lebre* in view of U.S. Patent No. 6,086,126 to *Krauss*, hereinafter “*Krauss*”. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP §2142, p. 2100-125 (8th ed., rev. 5, August 2006). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.

Id.

Claims 5 and 11 depend from allowable Claims 1 and 8, respectively, and therefore are also allowable as shown above. In addition, *Libre* fails to teach or disclose *a non-pivoted jaw structure* having an upper jaw portion and a lower jaw portion, the lower jaw portion having outer and inner surfaces, wherein *the inner surface is substantially flat and not parallel to the outer surface, the inner surface being operable to receive a portion of the CMP pad*, wherein the CMP pad is used to polish a semiconductor wafer,” as required by Claim 1 and ultimately by Claim 5. Similar arguments hold true for Claim 8 and its dependent, Claim 11.

Moreover, there is no suggestion or motivation within *Libre* to prompt one of ordinary skill to selectively combine discrete elements from each and then *seek out* still others as required by Claim 1 and ultimately by its dependent, Claim 5. Similar arguments hold true for Claim 8 and its dependent, Claim 11.

Libre, either alone or in any combination with *Krauss*, fails to teach or disclose *a non-pivoted jaw structure* having an upper jaw portion and a lower jaw portion, the upper jaw portion having an *arcuate lower surface for contacting portions of an upper surface of a chemical mechanical polishing pad used to polish a semiconductor wafer*, as required by Claim 15 and its dependents. In addition, Claim 15 and its dependents require that “the lower jaw portion having outer and inner surfaces, wherein the inner surface is substantially flat and not parallel to the outer surface, the inner surface being spaced below and opposite to the arcuate lower surface for slidably receiving a portion of the chemical mechanical polishing pad”.

In fact, *Lebre* merely teaches a clamping tong for plate-shaped loads having a two-tong jaw (i.e., jaw 1 and jaw 2) connected to each other by a *pivot pin*. (*Lebre*, column 1, lines 9-13; Figures 1 and 2). The jaw 1 forms one end of a double-armed lever 7. (*Id.* at column 1, line 45; Figures 1 and 2). On the lever end opposite to the jaw, another double armed lever 8 is *pivots connected by a pivot pin* 9. (*Id.* at column 1, lines 46-47; Figures 1 and 2). At most, *Lebre* teaches that *a roller 11 engages a control surface 12 is arranged to slant upward from the outer to the inner sides of the jaw* 2. (*Id.* at column 1, lines 53-56; Figures 1 and 2). When raising the carrying handle 10 in the direction of the arrow P, the teeth 4, 5 and 6 grip on a corner of the load T that is to be lifted, the lever 8 moves toward a vertical position. (*Id.* at column 1, lines 57-60; Figures 1 and 2). *Krauss* also fails to teach the required elements.

Moreover, there is no suggestion or motivation within *Lebre* or *Krauss* to prompt one of ordinary skill to selectively combine discrete elements from each and then *seek out* still others as required by Claim 15 and its dependents, Claims 16-20.

Accordingly, the Applicants respectfully request the Office to withdraw the §103 rejection with respect to these claims.

CONCLUSION

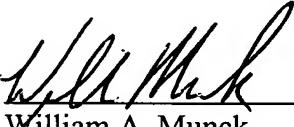
For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@munckbutrus.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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